



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,855	07/25/2003	Lauro Alvicio Volkart	024733-00010	9804

4372 7590 06/01/2006

ARENT FOX PLLC  
1050 CONNECTICUT AVENUE, N.W.  
SUITE 400  
WASHINGTON, DC 20036

EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
----------	--------------

3728

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/626,855

Applicant(s)

VOLKART, LAURO ALVICIO

Examiner

Anthony Stashick

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Specification***

1. The changes to the Specification filed January 17, 2006 have been accepted and entered.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-2 and 4-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 contains the phrases "enclosing the tubular elements in the absorber set" (line 9) and "wherein the tubular elements extend the entire width of the sports shoe and the outer ends of the tubular elements extend to an outer surface of the pair of laterally disposed walls." (lines 12-14) which render the claims vague and indefinite. It appears that these two limitations contradict themselves. It is not clear how the tubular elements are enclosed in the absorber set yet the outer ends of the tubular elements extend to an outer surface of the pair of laterally disposed walls.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 4, 6-9, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown 4,782,603 in view of Mayer 4,593,482. Brown '603 discloses all the limitations substantially as

Art Unit: 3728

claimed including the following: at least one absorber set 30 40 disposed in a sole of the sports shoe; the at least one absorber set having a plurality of tubular elements 60, 50 arranged parallel to one another and positioned transversely in relation to the longitudinal axis of the sports shoe (see Figure 2); the plurality of tubular elements being formed of at least one resilient material (polyurethane); a pair of laterally disposed walls (polyurethane) on opposite side ends of the plurality of tubular elements, enclosing the tubular elements in the absorber set (tubes located inside molten polyurethane then PU is cooled); the plurality of tubular elements in an unloaded state has an elliptical shape in cross-section (a circle is a special ellipse and therefore, the circular elements of Brown have an "elliptical" shape); at least one absorber set comprises a first absorber set disposed in a heel region of the sports shoe 30; a second absorber 50 set disposed in a front region of the sports shoe; the at least one absorber set is disposed along the entire length of the sports shoe (see Figures 1 and 2); the plurality of tubular elements have differing sizes, wall thicknesses and flexibilities (see differences between the tubes 60 and 50 of the absorber sets in Figures 1 and 2); the plurality of tubular elements have the same size, wall thicknesses and flexibility (see col. 1, lines 49-53, tubes of each set are the same size as other tubes of the same set); the at least one resilient material is a flexible polymer (polyurethane); the plurality of tubular elements are arranged at irregular intervals (between 30 and 40); the plurality of tubular elements are arranged at regular intervals (within their own sets); the interior of the plurality of tubular elements is filed with compressed air (when the user's foot applies pressure). Brown '603 does not specifically state or show that the tubular elements extend the entire width of the sports shoe and the outer ends of the tubular elements extend to an outer surface of the pair of laterally disposed walls. Mayer '482 teaches that a sole can be made of tubular elements that extend the entire width of the sole, including the ends extending to the outer surface of the sole. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to extend the tubular elements of Brown '603 to the outer wall surface to allow for compression of the tubes and allow the tube to absorb the impact of the user's foot with the ground. With

Art Unit: 3728

respect to the limitation that the tubular elements are detached from one another, none of the sides of the tubular elements are attached to one another in Brown '603. Each side is attached to a connection piece<sup>70</sup>, therefore the tubes are connected to a connection piece and not each other, thereby meeting the limitations as expressed in claim 1.

6. Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being obvious over the references as applied to claims 1 and 4 above. The references as applied to claims 1 and 4 above disclose absorbers that are located throughout the shoe sole. Therefore, splitting this up into different regions of the sole, i.e. the forefoot area, the heel area and the arch area would be well within the skill of one of ordinary skill in the art to allow the flexibility of the shoe sole as well as to allow for variability in the cushioning of the user's foot. With respect to claim 10, the material of Brown '603 uses a plastic (polyurethane) and nitril butadiene, which acts like a resin, therefore anticipating this limitation in the claim. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the tubular elements of the references as applied to claims 1 and 4 above out of a plastic as taught by Brown '603 mixed with resin (to hold the plastics together) to help in holding the tubular elements together during use.

### ***Response to Arguments***

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. The rejections set forth above address the applicant's remarks with respect to the added limitations.

***Conclusion***

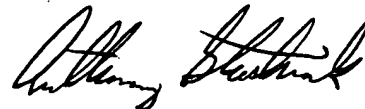
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3728

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS